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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,611
Filing Date: September 29, 2003
Appellant(s): BOYLE ET AL.

Thomas H. Majcher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/19/10 appealing from the Office action mailed 4/21/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Broome et al USPN 6,152,946

Berthiaume USPN 5,161,534

Ring USPN 3,459,184

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 7-10, and 12-27 are rejected under 35 U.S.C. 103 as being unpatentable over Broome et al USPN 6,152,946 in view of Berthiaume USPN 5,161,534 and further in view of Ring USPN 3,459,184.

Broome discloses the invention substantially as claimed being an embolic filtering system comprising a self-expandable nitinol filter frame (24) comprising a filter element (40) mounted on a guidewire (32) and a retractable sheath (64). However, Broome does not disclose the structure of the proximal end of the device comprising a torque device or use of a split seam-sheath.

Berthiaume teaches the use of a tool (10) for manipulating a medical guidewire comprising a handle (12) and a cap (14) that compresses collets onto a guidewire in the same field of endeavor for the purpose of providing the operator with a detachable means for torqueing and controlling a guidewire.

Ring teaches the use of a catheter comprising a split seam sheath (18) and a splitter (9). Ring further discloses the splitter comprises an extension arm (9) having a

Art Unit: 3738

distal end capable of receiving both the guidewire (7) and the sheath (18) and a side-port (Near reference number 21) that is offset from the central axis of the guidewire, wherein the guidewire causes the splitting of the sheath..

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the torque device of Berthiaume to the end of catheter of Broome in order to provide the user with a way to advance, rotate, and retract the filter through movement of the guidewire.

Furthermore it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a split seam sheath as taught by Ring to the catheter of Broome and to add the sheath splitter taught by Ring to the cap of the tool of Berthiaume in order to provide the user with a removable sheath and guiding it away from the handle of torque device.

(10) Response to Argument

Appellant argues that a plastic catheter as disclosed in the Ring patent can not be interpreted as a guide wire. The examiner disagrees because within the medical art there are numerous forms of guidewires including the use of numerous materials such as metal and plastics. It is also known that guidewires can be hollow. One of average skill within the art knows that the recitation for a guidewire is very broad. Within the medical art a guidewire is simply known as a wire that can be used as a rail or guide. The appellant is incorrectly providing too much weight to the claim language requiring a

Art Unit: 3738

guidewire. Element 7 of Ring meets all the minimum standards within the medical art of being a guidewire.

The appellant then argues that the catheter of Ring would not be strong enough to shear the sheath, but he fails to provide any factual support to this. The sheath of the combination provided by the rejection has a preformed slit, which if used in combination with the catheter would be sheared. The appellant further argues that the surface not the catheter is performing the shearing. The examiner disagrees because there are multiple factors that cause the separating of the sheath including both the surface and the catheter/guidewire. The inclined surface forces the sheath upwards causing the guidewire to shear the sheath along its seam.

The appellant continues to argue that Ring fails to disclose a separate side port because it is part of the spaced formed between the loop and the main body. The examiner disagrees because the device or Ring comprises two intersecting openings. There is a hollow bore extending from the end and there is a separate cutout that extends from the outer surface of the body inward.

The appellant then argues that there is no motivation to combine the references because the Ring patent is not used in combination with an embolic filter. This is not convincing because using the device of ring with an embolic filter will provide the operator with more room to work once the sheath has been split and removed. The appellant argues that with regards to claims 4 and 12 the tubular member extending from the extension arm was not disclosed. This is not convincing because it is abundantly clear from figure 1 of Ring that there is a tubular extension.

Art Unit: 3738

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Christopher D Prone/

Examiner, Art Unit 3738

Conferees:

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738

/Thomas C. Barrett/

Supervisory Patent Examiner, Art Unit 3775